

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Main claim 18 has been amended without prejudice to require that the colloidal preparation is in the absence of “added stabilizer.” Support for this amendment can be found at page 5, lines 13-15. Applicants respectfully submit that the amendment does not introduce new matter. An early notice to that effect is earnestly solicited.

Claims 1, 3-8, 10, 11 and 13-18 were rejected under 35 USC § 103(a) as being obvious over Beer, US 3,711,385, in view of Ioroi et al. (“Ioroi”), *J. Electrochem. Soc.*, 147: 2018-2022 (2000), and Applicants’ allegedly admitted prior art, optionally further in view of Bestaoui et al. (“Bestaoui”), *Chem. Mater.*, 9: 1036-1041 (1997).

Claim 12 was rejected under 35 USC § 103(a) as being obvious over Beer in view of Ioroi and Applicants’ allegedly admitted prior art, optionally further in view of Bestaoui.

In response to **both** rejections, Applicants respectfully submit that the cited combination of references does not make out a *prima facie* case of the obviousness of the rejected claims. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

According to *Manual of Patent Examining Procedure* (“MPEP”) § 2143:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations.”

Main claim 18 requires in step a) “preparing colloidal iridium oxide *in the absence of an added stabilizer * * **.” The Examiner relies on Ioroi to teach the process manipulations of the instant claims. However, Applicants respectfully point out that Ioroi teaches the addition of ascorbic acid, a known stabilizer. See, the right-hand column on page 2018. Accordingly, even if the combination of references were proper, which Applicants do not believe, the combination of references would still lead to the use of a stabilizer, which is now not permitted by the present claims.

Further, there is no teaching or suggestion in the combination of references of the instant limitation requiring “adjusting the pH to > 12.” The Examiner concedes (1) Ioroi teaches lowering the pH to ~ 8 but (2) Ioroi does not explicitly teach a pH of > 12. Applicants concede that a teaching that the pH is lowered to ~ 8 means the pH originally was higher than ~ 8, but, respectfully submit that the “starting” pH cannot be known and certainly cannot be concluded to be > 12. The Examiner seeks to get around these deficiencies by reliance on caselaw, alleging *In re Wertheim*, 191 USPQ 90 (CCPA 1976), stands for the proposition that “where the claimed ranges ‘overlap or lie inside ranges disclosed by the prior art’ a *prima facie* case of obviousness exists (emphasis added).” The problem is that this is *not* the factual situation involved here. Thus, it is not necessarily the case that a starting pH that is subsequently lowered to ~ 8 must have been > 12 to begin with. The starting pH could have been any pH between 8-12, *none of*

which overlaps with the claimed range or falls inside it. Consequently, there is in the combination of references no teaching or suggestion to adjust the pH to > 12, as required by the instant claims.

The Examiner takes this erroneous construction of the prior art and runs with it in the paragraph bridging pages 9-10 of the final rejection. The Examiner finds “that by combination of the prior art such reacting at such a pH was rendered obvious by the prior art, so as the prior art has taught increasing the pH to at least 12, it would additionally inherently for the disputed colloidal structure.” First, the claims do not require “increasing the pH to at least 12"; the claims require “adjusting the pH to [greater than] 12.” Second, as developed above, the prior art does not teach or suggest increasing the pH to > 12. Indeed, the prior art doesn’t even teach or suggest increasing the pH to 12.

Respectfully, there are gaps between the instant claims and the cited combination of references that are not bridged.

In view of the foregoing, Applicants respectfully submit that the cited combinations of references fail to make out a *prima facie* case of the obviousness of the rejected claims. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw both rejections. An early notice that these rejections have been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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